



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/755,787	01/05/2001	Paul Robert Carini	YOR920000056US1	5263

7590 10/23/2003

Ryan, Mason & Lewis, LLP  
90 Forest Avenue  
Locust Valley, NY 11560

EXAMINER
----------

BELL, PAUL A

ART UNIT	PAPER NUMBER
----------	--------------

2675

DATE MAILED: 10/23/2003

7

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/755,787

Applicant(s)

CARINI ET AL.

Examiner

PAUL A BELL

Art Unit

2675

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 June 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-50 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-50 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_                      6) ☐ Other: \_\_\_\_\_

Art Unit: 2675

## DETAILED ACTION

### Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 46 and 50 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With regard to claims 46 and 50 the phrase “permit a natural transition” is considered unclear, vague and indefinite because how does one determine what is natural and what is unnatural transition.

### Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-5, 7-15, 17-26, 28-36, 38-42, 44, 46, 48 and 50 are rejected under 35 U.S.C. 102(b) as being anticipated by Ruedisueli et al. (5,838,819).

With regard to independent claim 1, Ruedisueli et al. teaches a method of entering formatted electronic ink data provided in association with a user on a handwriting system (abstract and figure 1), the method comprising the steps of: positioning one or more pieces of writing medium to substantially overlay at least a portion of a digitizing surface associated with the handwriting system (figure 2, items 30 “paper” and 32 “clip”), physically entering handwritten data on the one or more pieces of writing medium using a stylus associated with the handwriting

Art Unit: 2675

system such that, substantially simultaneous therewith, the electronic ink data representing the physically entered handwritten data is entered at the digitizing surface (figures 2 and 3, item 34 shows a hand physically putting ink on the paper on top of the digitizer), wherein the one or more pieces of writing medium are configured to have a predefined format including one or more fields associated with the predefined format such that the on electronic ink data entered at the digitizing surface is computer parse able based on the one or more fields (column 2, lines 10-31), and further wherein a field comprises a delimited area of the writing medium (figure 2 shows an identifier item 36 being put in a region (or delimited area) for recording the page number and figure 3 shows another region (or delimited area) for recording a graph with a label), and providing one or more user-specified indications to indicate that electronic ink data entered in association with the one or more user-specified indications is to be associated with one or more fields (figures 2 and 3 whereby the user can see the ink as he writes it on the paper associated with the page number reads on this broad language), so as to permit a transition between the entry of electronic ink data in accordance with the one or more fields and entry of electronic ink data that is not associated with the one or more fields (column 4, lines 5-16 also see column 2, lines 10-31 whereby the user has the capability to determine which data to be entered is associated or not associated with a specific “page” or “session” reads on this broad language).

With regard to independent claim 18, Ruedisueli et al. teaches a method of entering formatted electronic ink data provided in association with a user on a handwriting system (abstract and figure 1), the method comprising the steps of: positioning one or more pieces of

Art Unit: 2675

writing medium to substantially overlay at least a portion of a digitizing surface associated with the handwriting system (figure 2, items 30 “paper” and 32 “clip”), physically entering handwritten data on the one or more pieces of writing medium using a stylus associated with the handwriting system such that, substantially simultaneous therewith, the electronic ink data representing the physically entered handwritten data is entered at the digitizing surface (figures 2 and 3, item 34 shows a hand physically putting ink on the paper on top of the digitizer), and providing one or more user-specified indications to indicate that electronic ink data entered in association with the one or more user-specified indications is to be associated with one or more fields of a predefined format (figures 2 and 3 whereby the user can see the ink as he writes it on the paper associated with the page number reads on this broad language), wherein a field comprises a delimited area of the writing medium (figure 2 shows an identifier item 36 being put in a region (or delimited area) for recording the page number and figure 3 shows another region (or delimited area) for recording a graph with a label), such that the electronic ink data entered in association therewith at the digitizing surface is computer parse able based on the one or more fields (column 2, lines 10-31), and such as to permit a transition between the entry of electronic ink data in accordance with the one or more fields and entry of electronic ink data that is not associated with the one or more fields (column 4, lines 5-16 also see column 2, lines 10-31 whereby the user has the capability to determine which data to be entered is associated or not associated with a specific “page” or “session” reads on this broad language).

Art Unit: 2675

With regard to independent claim 22, Ruedisueli et al. teaches a handwriting system for entering formatted electronic ink data provided in association with a user, the system (abstract and figure 1), comprising: a digitizing surface (figure 2, item 26); a stylus (figure 2, item 34 “pen”); and one or more pieces of writing medium (figure 2, items 30 “paper” and 32 “clip”), wherein the one or more pieces of writing medium are positioned to substantially overlay at least a portion of the digitizing surface such that handwritten data can be physically entered on the one or more pieces of writing medium using the stylus such that, substantially simultaneous therewith the electronic ink data representing the physically entered handwritten data is entered at the digitizing surface (figures 2 and 3, item 34 shows a hand physically putting ink on the paper on top of the digitizer). further wherein the one or more pieces of writing medium are configured to have a predefined format including one or more fields associated with the predefined format such that the electronic ink data entered at the digitizing surface is computer parse able based on the one or more fields (column 2, lines 10-31), wherein a field comprises a delimited area of the writing medium (figure 2 shows an identifier item 36 being put in a region (or delimited area) for recording the page number and figure 3 shows another region (or delimited area) for recording a graph with a label), such that one or more user-specified indications can be provided to indicate that electronic ink data entered in association with the one or more user-specified indications is to be associated with the one or more fields (figures 2 and 3 whereby the user can see the ink as he writes it on the paper associated with the page number reads on this broad language), so as to permit a transition between the entry of electronic ink data in accordance with the one or more

Art Unit: 2675

fields and entry of electronic ink data that is not associated with the one or more fields (column 4, lines 5-16 also see column 2, lines 10-31 whereby the user has the capability to determine which data to be entered is associated or not associated with a specific “page” or “session” reads on this broad language).

With regard to independent claim 39, Ruedisueli et al. teaches a handwriting system for entering formatted electronic ink data provided in association with a user (abstract and figure 1), the system comprising: a digitizing surface (figure 2, item 26); a stylus (figure 2, item 34 “pen”); and one or more pieces of writing medium (figure 2, items 30 “paper” and 32 “clip”) wherein the one or more pieces of writing medium are positioned to substantially overlay at least a portion of the digitizing surface such that handwritten data can be physically entered on the one or more pieces of writing medium using the stylus such that, substantially simultaneous therewith the electronic ink data representing the physically entered handwritten data is entered at the digitizing surface (figures 2 and 3, item 34 shows a hand physically putting ink on the paper on top of the digitizer). further wherein one or more user-specified indications can be provided in accordance with the one or more pieces of writing medium to indicate that electronic ink data entered in association with the one or more user-specified indications is to be associated with one or more fields of a predefined format (figures 2 and 3 whereby the user can see the ink as he writes it on the paper associated with the page number reads on this broad language), wherein a field comprises a delimited area of the writing medium (figure 2 shows an identifier item 36

Art Unit: 2675

being put in a region (or delimited area) for recording the page number and figure 3 shows another region (or delimited area) for recording a graph with a label), such that the electronic ink data entered in association therewith at the digitizing surface is computer parse able based on the one or more fields (column 2, lines 10-31), and such as to permit a transition between the entry of electronic ink data in accordance with the one or more fields and entry of electronic ink data that is not associated with the one or more fields (column 4, lines 5-16 also see column 2, lines 10-31 whereby the user has the capability to determine which data to be entered is associated or not associated with a specific "page" or "session" reads on this broad language).

With regard to claim 2 Ruedisueli et al. teaches wherein at least one of the pieces of writing medium has the predefined format for entry of electronic ink data in accordance with the one or more fields and at least one of the pieces of writing medium does not have the predefined format, such that the user may transition between the two pieces of writing medium when performing formatted electronic ink data entry and unformatted electronic ink data entry, respectively (figure 5b item 36 and item 50 and figure 5c item 54).

With regard to claim 3 Ruedisueli et al. teaches wherein the one or more fields of the one or more pieces of writing medium are preprinted in watermark form thereon, such that the user may transition between performing formatted electronic ink data entry and unformatted electronic ink data entry on the same piece of writing medium (figure 12).



Art Unit: 2675

With regard to claim 4 Ruedisueli et al. teaches wherein the one or more fields of the predefined format are associated with a label (page number is a label also figure 2 shows the user putting a label on the graph).

With regard to claim 5 Ruedisueli et al. teaches wherein the label is associated with an information management function (the page number helps you keep track of your notes).

With regard to claim 7 Ruedisueli et al. teaches wherein the user-specified indication providing step further comprises the step of the user signaling the beginning of entry of formatted electronic ink data in accordance with the one or more fields (figure 4, item 40).

With regard to claim 8 Ruedisueli et al. teaches wherein the user-specified indication providing step further comprising the step of the user signaling completion of entry of formatted electronic ink data in accordance with the one or more fields (figure 4, item 42).

With regard to claim 9 Ruedisueli et al. teaches further comprising the step of providing the user with feedback relating to the user's entry of formatted electronic ink data in accordance with the one or more fields (figures 2 and 3 the user can see the ink on the paper).

With regard to claim 10 Ruedisueli et al. teaches wherein the feedback is at least one of auditory and visible (figures 2 and 3 the user can see the ink on the paper).

With regard to claim 11 Ruedisueli et al. teaches wherein the feedback relates to whether or not the user is writing within one of the fields (figures 2 and 3 the user can see the ink on the paper).

Art Unit: 2675

With regard to claim 12 Ruedisueli et al. Teaches wherein the feedback relate to whether or not the user has completed one or more required fields (the page number entered by user reads on “required field” because it is needed to store the data with the correct page).

With regard to claim 13 Ruedisueli et al. teaches wherein the handwriting system is a personal digital notepad (figure 2 and 12).

With regard to claim 14 Ruedisueli et al. teaches wherein the one or more pieces of writing medium are bound together to form a grouping (column 11, lines 18-29).

With regard to claim 15 Ruedisueli et al. teaches wherein at least one of the pieces of writing medium has a carbon paper backing (column 9, line 19).

With regard to claim 17 Ruedisueli et al. teaches wherein at least one of the pieces of writing medium has the predefined format on only a portion of the writing medium (figure 7c, item 68).

With regard to claim 19 Ruedisueli et al. teaches, wherein at least one of the user-specified indications comprises at least one of a letter, a symbol and a word (figures 2 and 3 show letters, numbers and a graph).

With regard to claim 20 Ruedisueli et al. teaches wherein at least one of the user-specified indications comprises at least one handwritten stroke (figure 3).

With regard to claim 21 Ruedisueli et al. Teaches further comprising the step of permitting at least one of user addition, deletion and modification of one or more fields (column 2, lines 25-29)

Art Unit: 2675

With regard to claim 23 Ruedisueli et al. teaches wherein at least one of the pieces of writing medium has the predefined format for entry of electronic ink data in accordance with the one or more fields and at least one of the pieces of writing medium does not have the predefined format, such that the user may transition between the two pieces of writing medium when performing formatted electronic ink data entry and unformatted electronic ink data entry, respectively (figure 5b item 36 and item 50 and figure 5c item 54).

With regard to claim 24 Ruedisueli et al. teaches wherein the one or more fields of the one or more pieces of writing medium are preprinted in watermark form thereon, such that the user may transition between performing formatted electronic ink data entry and unformatted electronic ink data entry on the same piece of writing medium (figure 12).

With regard to claim 25 Ruedisueli et al. teaches wherein the one or more fields of the predefined format are associated with a label (page number is a label).

With regard to claim 26 Ruedisueli et al. teaches wherein the label is associated with an information management function (the page number helps you keep track of your notes).

With regard to claim 28 Ruedisueli et al. teaches, wherein, in accordance with the one or more user specified indications, the system is further operative to permit the user to signal the beginning of entry of formatted electronic ink data in accordance with the one or more fields (figure 4, item 40).

With regard to claim 29 Ruedisueli et al. teaches wherein in accordance with the one or more user specified indications, the system is further operative to permit the user to signal

Art Unit: 2675

completion of entry of formatted electronic ink data in accordance with the one or more fields (figure 4, item 42).

With regard to claim 30 Ruedisueli et al. teaches wherein the system is further operative to provide the user with feedback relating to the user's entry of formatted electronic ink data in accordance with the one or more fields (figures 2 and 3 the user can see the ink on the paper).

With regard to claim 31 Ruedisueli et al. teaches wherein the feedback is at least one of auditory and visible (figures 2 and 3 the user can see the ink on the paper).

With regard to claim 32 Ruedisueli et al. teaches wherein the feedback relates to whether or not the user is writing within one of the fields (figures 2 and 3 the user can see the ink on the paper).

With regard to claim 33 Ruedisueli et al. Teaches wherein the feedback relate to whether or not the user has completed one or more required fields (the page number entered by user reads on "required field" because it is needed to store the data with the correct page).

With regard to claim 34 Ruedisueli et al. teaches wherein the handwriting system is a personal digital notepad (figure 2 and 12).

With regard to claim 35 Ruedisueli et al. teaches wherein the one or more pieces of writing medium are bound together to form a grouping (column 9, line 19).

With regard to claim 36 Ruedisueli et al. teaches wherein at least one of the pieces of writing medium has a carbon paper backing (column 9, line 19).

Art Unit: 2675

With regard to claim 38 Ruedisueli et al. teaches, wherein at least one of the pieces of writing medium has the predefined format on only a portion of the writing medium (figure 7c, item 68).

With regard to claim 40 Ruedisueli et al. teaches, wherein at least one of the user-specified indications comprises at least one of a letter, a symbol and a word (figures 2 and 3 show letters, numbers and a graph).

With regard to claim 41 Ruedisueli et al. teaches wherein at least one of the user-specified indications comprises at least one handwritten stroke (figure 3).

With regard to claim 42 Ruedisueli et al. Teaches further comprising the step of permitting at least one of user addition, deletion and modification of one or more fields (column 2, lines 25-29)

With regard to claim 44 all of the limitation were addressed above by Ruedisueli et al. in claims 1, 9 and 12.

With regard to claim 46 all of the limitation were addressed above by Ruedisueli et al. in claims 18 and 21.

With regard to claim 48 all of the limitation were addressed above by Ruedisueli et al. in claims 22, 30 and 33.

With regard to claim 50 all of the limitation were addressed above by Ruedisueli et al. in claims 39 and 42.

Art Unit: 2675

**Claim Rejections - 35 USC § 103**

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 6, 27, 43 and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ruedisueli et al. as applied to claims 1, 4, 5, 22, 25, 26, above, and further in view of Gusack (5,921,582).

With regard to claims 6 and 27 Ruedisueli et al. does not illustrate wherein the information management function comprises at least one of an appointment recording function, a phone message recording function and a listing function of task to be accomplished. However this recited use of the digitizer is viewed as merely directed toward an "OBVIOUS INTENDED USE" of the Ruedisueli et al. digitizer.

Gusack teaches, wherein the information management function comprises a listing of task to be accomplished (See Gusack figure 19 listing of task 1-6).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use Ruedisueli et al. digitizer to perform tasking as taught by Gusack because the Ruedisueli et al. apparatus is capable of being used that way and Gusack which is analyst art shows a similar digitizer being used that way which lends support to the concept of a recitation merely directed towards an obvious intended use.

Art Unit: 2675

With regard to claim 43 all of the limitation were addressed above by Ruedisueli et al.  
And Gannage et al. in claims 1, 4, 5 and 6 above.

With regard to claim 47 all of the limitation were addressed above by Ruedisueli et al.  
And Gannage et al. in claims 22, 25, 26 and 27 above.

7. Claims 16, 37, 45 and 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ruedisueli et al. as applied to claims 1, 22 above, and further in view of Gannage et al. (6,504,956).

With regard to claims 16 and 37 Ruedisueli et al. does not illustrate wherein at least one of the pieces of writing medium has an at least partially adhesive backing. However he does in column 11, lines 20-22 state, "the means for attaching a paper, such as clip 32" this language "such as" extends the expression to suggest other means which are obvious alternatives such as adhesive.

Gannage et al. teaches using paper for his digitizer in the form of "Post-it" notes (See Gannage et al. abstract, figure 5) which have an adhesive backing.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Ruedisueli et al. to use adhesive backed paper as taught by Gannage et al. because the Ruedisueli et al. base reference directly uses suggestive language directed towards all obvious equivalent alternatives for "means for attaching" and further since Gannage et al. is analysis art, the alternatives offered by Gannage et al. would of have been considered at time of invention by one of ordinary skill.

Art Unit: 2675

With regard to claim 45 all of the limitation were addressed above by Ruedisueli et al.  
And Gannage et al. in claims 1 and 16 above.

With regard to claim 49 all of the limitation were addressed above by Ruedisueli et al.  
And Gannage et al. in claims 22 and 37 above.


### Conclusion


8. Applicant's arguments filed 6 June 2003 have been fully considered but they are not persuasive. With regards to applicants arguments in view of the newly amended independent claims the examiner disagrees and references the more detailed response to the new limitations above.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Bell whose telephone number is (703) 306-3019. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven Saras, can be reached at (703) 305-9720.

Any response to this action should be mailed to: Commissioner of Patents and Trademarks  
Washington, D.C. 20231  
or faxed to: (703) 872-9314

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist). Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.

  
Paul Bell  
Art unit 2675  
14 October 2003

  
STEVEN SARAS  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600